

### R E M A R K S

Careful review and examination of the subject application are noted and appreciated. Applicant's representative thanks Examiner Chang for the indication of allowable subject matter.

### SUPPORT FOR CLAIM AMENDMENTS

Support for the amendments to the claims can be found in the drawings as originally filed, for example in FIGS. 7-10 and 23 and in the specification as originally filed, for example on page 7, line 22 through page 10, line 2. As such, no new matter has been introduced.

### CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-4, 16-20, 32 and 33 under 35 U.S.C. §103(a) as being unpatentable over Sahlman et al. (U.S. Pat. No. 6,693,902; hereinafter Sahlman) in view of McMillen et al. (U.S. Pat. No. 6,243,361; hereinafter McMillen) has been obviated by appropriate amendment and should be withdrawn.

The rejection of claims 6-15, 22-31, 34-52 and 54 under 35 U.S.C. §103(a) as being unpatentable over Sahlman in view of McMillen and further in view of Ohara (U.S. Patent No. 5,144,297) has been obviated, in part, by appropriate amendment and is respectfully traversed in part and should be withdrawn.

The allowable matter of claim 53 has been incorporated into claim 1. Subject matter similar to the allowable matter of

claim 53 has been incorporated into claims 17 and 33-36. As such, the presently claimed invention is fully patentable over the cited references and the rejections should be withdrawn.

Claims 2-4, 6-16, 18-20 22-32, and 54 depend, directly or indirectly, from either claim 1 or claim 17 which are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejections should be withdrawn.

Furthermore, the Office Action does not appear to be complete with respect to claims 37-52 (see 37 CFR 1.104). Specifically, claim 37 recites "A digital cross connect comprising plural switching stages, each stage having plural switches on plural chips receiving plural frames of time multiplexed input data and switching the data in time and space, switches of different stages being on common chips supporting respective framing time bases for the different stages." Claim 41 recites "A switch circuit on an integrated circuit chip comprising switch circuitry receiving plural frames of time multiplexed input data and switching the data in time and space, a first frame counter to which a first portion of the plural frames of time multiplexed input data is synchronized and a second frame counter to which a second portion of the plural frames of time multiplexed input data is synchronized." Although the Office Action cites Sahlman, McMillen and Ohara, the Office Action does not expressly state how the references are applied to each of the specifically claimed limitations recited in claims 37-52.

For example, the Office Action does not point out where the cited references teach or suggest the specific limitations of "each stage having plural switches **on plural chips**" or "switches of different stages being **on common chips** supporting respective framing time bases for the different stages" as recited in claim 37. The Office Action also does not point out why one of ordinary skill in the field of the invention would consider a counter mounted in a signal generator (as recited in column 6, lines 25-30 of Ohara) as teaching or suggesting the specific limitation of "**a first frame counter** to which a first portion of the plural frames of time multiplexed input data is synchronized **AND a second frame counter** to which a second portion of the plural frames of time multiplexed input data is synchronized" as recited in claim 41. In particular, "a counter," as recited in Ohara, is singular and generic, and therefore does not teach or suggest **a first frame counter AND a second frame counter**, as presently claimed.

Furthermore, the rejection of the dependent claims 38-40 and 42-52 with the mere statement that the claims have limitations that are similar to the respective independent claims and thus are rejected with the same rationale applied against the independent claims (see page 6, line 16 through page 7, line 6 of the Office Action) does not appear to be a proper rejection. In particular, the rejection fails to specifically address the specific limitations of each dependent claim and clearly show how the cited references are considered to read on the specific limitations.

Therefore the rejection does not appear to be proper and should be withdrawn.

Since the Office Action does not identify exactly what portions of the applied references are considered to teach or suggest each of the specific limitations recited in claims 37-52 (see pages 5-7 of the Office Action), it follows that the Office Action is not complete as to all matters regarding claims 37-52. Accordingly, the Office Action fails to meet the Office's burden to establish a factual basis to support a *prima facie* conclusion of obviousness. Therefore the rejection does not appear to be sustainable and should be withdrawn.

Furthermore, Applicant's representative traverses the Examiner's suggestion that it is inherent in Sahlman that a configuration select signal as presently claimed is carried via the A1 byte for OAM applications (see pages 4-5, line 21-line 3 of the Office Action). Inherency requires certainty of results, not mere possibility. See, e.g., *Ethyl Molded Products Co. v. Betts Package, Inc.*, 9 U.S.P.Q. 2d 1001 (E.D.Ky 1988). The Office Action does not identify exactly what portions of the Sahlman are relied upon for the conclusion of inherency (see page 4, lines 21 through page 5, line 3 of the Office Action). Accordingly, the Office Action fails to establish a factual basis to support a *prima facie* conclusion of obviousness with respect to claims 2-4 and 18-20.

New claims 55-58 depend, directly or indirectly, from either claim 1, claim 37 or claim 41, which are believed to be

allowable. As such; the presently claimed invention is fully patentable over the cited references.

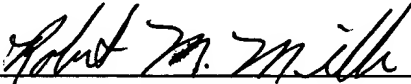
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative between the hours of 9 a.m. and 5 p.m. ET at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,

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Dated: July 31, 2006

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Docket No.: 04-0501 / 1496.00407